

U.S. Patent Application Serial No. 09/763,531
Amendment dated February 27, 2004
Reply to OA of September 29, 2003

REMARKS

Claims 1-24 are pending in this application. Claims 1, 14 and 16 are amended herein.

The Examiner indicates on the Office action summary page that claims 1-9, 14-16, 18 and 21-24 are subject to restriction and/or election requirement. Applicants believe that this is a clerical error; the Examiner apparently meant to indicate that these claims were rejected.

Applicants telephoned the Examiner on October 14, 2003, to confirm that the Amendment of August 18, 2003, had been entered.

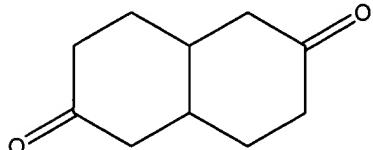
Claims 16 and 18 are rejected under 35 U.S.C. §102(b) as being anticipated by Dodds et al. (*J. Chem. Soc. Chem. Commun.* (1982) 1080-1081) and Jones et al. (*Can. J. Chem.* 65, 2937-2404 (1987)).
(Office action paragraph no. 3)

The rejection of claim 16 is overcome by the amendment to claim 16. The rejection of claim 18 is respectfully traversed.

Applicants note that the Examiner's reference to *Can. J. Chem.* apparently refers to Jones et al., *Can. J. Chem.* 1987. (The two papers are both written by Jones and Dodds, but the order of the authors is different in the two papers).

With regard to claim 16, the Examiner refers to compound (3) in Dodds et al., and compound (2) in Jones et al., which have the general structure:

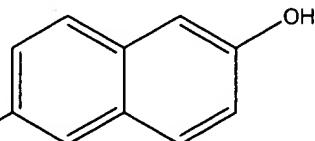
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, and are in the trans form, as anticipating structure (V-1). In the amendment,

structure (V-1) has been deleted from claim 16.

The Examiner considers scheme I of Jones et al. (*Can. J. Chem.*) to anticipate claim 18. This scheme



involves reduction of HO . However, the reduction does not involve hydrogen,

as required by claim 18. Therefore, Applicants respectfully submit that claim 18 is not anticipated by these references.

Claims 1-9, 14, 15 and 21-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Petrzilka et al. (U.S. 4,432,885).

The rejection is overcome by the amendment to claims 1 and 14.

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With regard to claim 1, Applicants respectfully submit that, before the present amendment, the only overlap between the compounds recited in claim 1 and the structures of Petrzilka's formula XXI/XXII occurs when R¹³ in Petrzilka's formula XXI is alkoxy.

In the present amendment to claim 1, excluded cases (i) and (ii) have been amended to remove the recitation regarding R or Z bonded to the decahydronaphthalene ring. The decahydronaphthalene ring in claim 1 corresponds to the two rings in Petrzilka's formula XXI when ring B is saturated, and therefore the R or Z bonded to this ring would correspond to Petrzilka's R¹³. By the present amendment deleting this recitation, the case where R or Z can be alkoxy is now included in the exclusion. That is, the amended excluded case (ii) can exclude compounds XXI/XXII of the Petrzilka reference having a trans-1,4-disubstituted cyclohexane ring as ring A, and the amended proviso (iii) can exclude compounds XXI/XXII of the Petrzilka reference having 1,4-phenylene group as ring A.

This amendment therefore broadens the excluded cases and correspondingly narrows claim 1. Applicants submit that with this amendment there is no overlap between the compounds of claim 1 and those of Petrzilka's formula XXI/XXII, and Petrzilka's formula XXI/XXII therefore cannot anticipate or suggest the recitation of claims 1-9, 21 or 22.

With regard to claim 14, the Examiner is apparently stating that the compound in Scheme A in column 34, line 25, of the reference, would correspond to the compound of claim 14 when m = 0. Claim 14 has been amended to change the recitation of variable m: "m represents an integer of 0-2 1 or 2". That is, the amendment to claim 14 eliminates the case where m = 0. Applicants respectfully submit that this amendment eliminates any overlap between the compounds of claim 14 and those of the reference.

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Claims 23 and 24 are rejected under 53 U.S.C. 103(a) as being unpatentable over U.S. 4,432,885 above.

The rejection of claims 23 and 24 is overcome by the amendment to claim 1. As discussed above, Applicants submit that claim 1, as amended, is novel and non-obvious over Petrzilka et al. (U.S. 4,432,885).

Claims 10-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The objection is overcome by the amendment to claim 1. Applicants submit that base claim 1, as amended, is not anticipated by nor obvious over the cited reference.

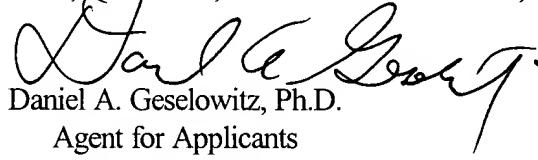
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If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicants undersigned agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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